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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,237	09/09/2003	August Van Der Beek	102126-31 (15)	4109
27388	7590	10/18/2004	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			NGUYEN, JIMMY T	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/658,237	Applicant(s) VAN DER BEEK ET AL.	
	Examiner Jimmy T Nguyen	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09092003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show an actuator (17) as described in the specification (page 6, line 6). Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

In the abstract, the first two sentences should be replaced by the following sentence: ---

A method and a briquetting press for briquetting metal chips wherein stable briquettes/pressed

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components are produced. The --- in order to conform to US rules. Correction is required. See MPEP § 608.01 (b).

In paragraph 1, line 2, before the word “which”, the following words should be added --- now US patent number 6,782,595, ---.

On page 6, line 11, reference numeral “9” should be changed to --- 8 ---.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Regarding claim 1, lines 12-13, the specification does not provide support for the limitation “the resulting pressed article length”. The specification discloses “an actual length of the pressed article” (page 6, line 20).

Regarding claim 3, line 2, the specification does not provide support for the limitation “fixing and/or adjusting the briquette length”. The specification discloses “determining and/or adjusting the briquette length” (page 4, lines 16-17).

Regarding claim 4, line 2, the specification does not support the limitation “piston rods of the pressing sleeves”. The specification discloses “a piston rod of the pressing ram” (page 4, line 18).

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 10, it is unclear whether “at least one press ram” is the same “press ram as claimed in line 8.

Regarding claim 1, line 10, it is unclear how the pressed article is being formed before performing the ejecting step. Examiner suggests that after the word “reached” (step c, line 2), the words --- and a pressed article is formed ----.

Regarding claim 1, line 13, it is unclear what “nominal length” applicant refers to. Examiner suggests --- a nominal length of the pressed article ---.

Regarding claim 1, line 14, before (*Lactual*), the words “the actual length” should be added.

Regarding claim 1, line 14, before (*Lnominal*), the words “the nominal length” should be added.

Regarding claim 2, line 3, “*Perf*” should be changed to --- *Preq* ---.

Regarding claim 3, line 2, it is unclear which “the briquette length” applicant refers to. Does it refer to the article length of the nominal length?

Regarding claim 4, line 3, the word “an” should be deleted.

Regarding claim 6, line 1, the limitation “further comprising the step of utilizing ...” fails to further limit the subject matter as claimed in the preceding claim 5, which already calls for the

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step of utilizing. Examiner suggests the words “further comprising” should be changed to --- wherein in ---.

Regarding claim 6, lines 4 and 6, it is unclear of what “triggers a command”. Examiner suggests --- the electronic logic module triggers a command...--- (emphasis added).

Regarding claim 8, line 1, it is unclear whether the second occurrence “a briquetting press” is the same press as the first occurrence “a briquetting press”. Examiner suggests that the second occurrence word of “a briquetting press” should be deleted.

Regarding claim 8, line 4, it is unclear what is being comprised. Examiner suggests that the words --- the briquetting press --- should be added before the word “comprising”.

Regarding claim 8, line 9, the limitation “the piston rods of the press ram” fails to further limit the subject matter as claimed in the preceding sentence of the claim, which calls for only one piston rod for each press ram. Examiner suggests the word “ram” should be changed to --- rams ---.

Regarding claim 8, lines 9-10, the limitation “at least one measuring device” means one or more than one measuring device. The specification does not support the piston rods accommodate one measuring device. The specification discloses that each piston rod is provided with a measuring device (page 5, lines 3-4).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 8, as best understood, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,782,595. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

a pressing sleeve including an opening, a metering device, and a stamper as claimed (claim 9, lines 4-7);

two press rams in the pressing sleeve, each having a piston rod (claim 9, lines 8-9);
each piston rod of the press rams accommodates a measuring device (claim 9, lines 11-12);

a control circuit, actuators, and a logic module as claimed (claim 9, lines 13-21).

Allowable Subject Matter

Claims 1-7 appear to have allowable subject matter. However, in view of the issues under 35 USC 112 rejections, the allowability of the claims cannot be determined at this time.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy T Nguyen whose telephone number is (703) 305-5304. The examiner can normally be reached on Mon-Thur 8:00am - 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen Ostrager can be reached on (703) 308-3136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTNguyen
October 13, 2004



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